

MAR 30 2005



DUANE MORRIS LLP  
380 LEXINGTON AVENUE  
NEW YORK, NY 10168  
PHONE: 212.692.1000  
FAX: 212.692.1020

## FACSIMILE TRANSMITTAL SHEET

**To:** Examiner Vanel Frenel  
**FIRM/COMPANY:** U.S. Patent and Trademark Office  
**FACSIMILE NUMBER:** (703) 872-9306  
**FROM:** Joseph R. Carvalko, Jr.  
**DIRECT DIAL:** (212) 692-1052  
**DATE:** March 29, 2005  
**USER NUMBER:** 5668  
**SERIAL NUMBER:** 09/676,391  
**TOTAL # OF PAGES:** 3  
**(INCLUDING COVERSHEET)**  
**MESSAGE:**

### CONFIDENTIALITY NOTICE

THIS FACSIMILE TRANSMISSION IS PRIVILEGED AND CONFIDENTIAL AND IS INTENDED ONLY FOR THE REVIEW OF THE PARTY TO WHOM IT IS ADDRESSED. IF YOU HAVE RECEIVED THIS TRANSMISSION IN ERROR, PLEASE IMMEDIATELY TELEPHONE THE SENDER ABOVE TO ARRANGE FOR ITS RETURN, AND IT SHALL NOT CONSTITUTE WAIVER OF THE ATTORNEY-CLIENT PRIVILEGE.

If there is a problem with this transmission, please call us as soon as possible at 212.692.1000.

PTOL-413A (09-04)  
Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

## Applicant Initiated Interview Request Form

Application No.: 09/676,391 First Named Applicant: Marcia Rojewski  
Examiner: \_\_\_\_\_ Art Unit: \_\_\_\_\_ Status of Application: \_\_\_\_\_

## Tentative Participants:

(1) Joseph R. Carvalko, Jr. (2) Examiner Vanel Fennel  
(3) Joseph Thomas (Supervisor) (4) \_\_\_\_\_Proposed Date of Interview: April 5, 2005 Proposed Time: 2 pm (AM/PM)

## Type of Interview Requested:

(1)  Telephonic (2)  Personal (3)  Video ConferenceExhibit To Be Shown or Demonstrated:  YES  NO  
If yes, provide brief description: \_\_\_\_\_

## Issues To Be Discussed

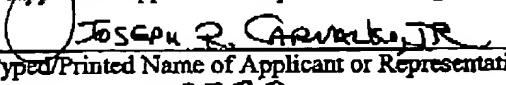
Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>103</u>	<u>Cl. 1-21</u>	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

 Continuation Sheet Attached

## Brief Description of Arguments to be Presented:

(SEE ATTACHED) New grounds of rejection Mutch's "Risk & Insurance Technology: Unlocking the Neural Network" and Hann's High-tech sleuth do not support 103 rejection.An interview was conducted on the above-identified application on \_\_\_\_\_.  
NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

  
\_\_\_\_\_  
Applicant/Applicant's Representative Signature\_\_\_\_\_  
Examiner/SPE Signature  
\_\_\_\_\_  
Typed/Printed Name of Applicant or Representative

29779

\_\_\_\_\_  
Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 123 and 37 CFR 1.11 and 1.14. This collection is estimated to take 20 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**ISSUES TO BE DISCUSSED**

The examiner has rejected claims 1-21 under 35 USC § 103(a) as being unpatentable over Mutch's article Risk & Insurance; Technology: Unlocking the Neural Network (Jan. 1999) in view of Hann's article High-tech sleuths (Nov. 1998).

The test for obviousness fails because neither prior art reference or combined references teach or suggest all the claims limitations in the present invention. Respectfully, the fact that an article (in this case in connection with neural networks and not the subject of the present invention) uses the word "computerized" does not remove the requirement that the claimed elements of the present invention must be present in one of the references. Neither reference alone or in combination disclose:

receiving data indicative of a plurality of claims;  
automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data;  
automatically identifying risk factors for each of the select claims; and,  
automatically calculating each of the select claims dependently upon the base scores and identify risk factors to provide a value indicative of an expected subrogation recovery.

The foregoing elements must be present in either of the references and they are not.

Respectfully, the fact that an article uses the assertion: "Fraudulent claims in workers' compensation "easily outstrip those in other lines of business, "according to the report" does not remove the requirement that this be shown to relate to the element of "outputting the resulting value." In fact, the Hann article deals with fraud management and not subrogation which is the assumption by third party (as a second creditor or an insurance company) of another persons legal right to collect a debt or damage award.